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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/554,091	08/14/2006	Hiroshi Ito	P/5495-2	2897
2352 7590 06/22/2009 OSTROLENK FABER GERB & SOFFEN 1180 AVENUE OF THE AMERICAS NEW YORK, NY 100368403				
EXAMINER				
LEA, CHRISTOPHER RAYMOND				
ART UNIT		PAPER NUMBER		
1619				
MAIL DATE		DELIVERY MODE		
06/22/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/554,091

Applicant(s)

ITO ET AL.

Examiner

Christopher R. Lea

Art Unit

1619

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 June 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-49 is/are pending in the application.
- 4a) Of the above claim(s) 2, 4-23, 26, 27 and 35-49 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3, 24, 25 and 28-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 October 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
- Paper No(s)/Mail Date 10/21/2005
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

This application is a 371 (national stage application) of PCT/JP04/05763.

Claims 1-49 are pending. Claims 1, 3, 24, 25, & 28-34 are under examination.

Election/Restrictions

1. Applicant's election of Group I, claims 1, 3, 24, 25, & 28-34, in the reply filed on June 10, 2009, is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).
2. Claims 2, 4-23, 26, 27, & 35-49 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on June 10, 2009.

Priority

3. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Information Disclosure Statement

4. The information disclosure statement(s) (IDS) submitted on October 21, 2005, was filed before the mailing date of the first office action on the merits. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information

disclosure statement is being considered by the examiner. Any references not complying with 37 CFR 1.98 have been lined through and reason for non-compliance given on the form.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1, 3, 24, 25, & 31-34 are rejected under 35 U.S.C. 102(b) as being anticipated by Ishihara et al. (JP 2003-102813, witnessed by the machine translation previously supplied to applicant).

Claim 1 & 3: Ishihara et al. disclose a composition of cellulose particles (paper powder) that supports a metal and/or metal hydroxide compound (claim 1). Ishihara et al. disclose that if zinc and copper metals and hydroxides thereof are particularly desired as the metals if deodorizing function is desired (paragraphs 6 & 9, working example 1).

Claims 24 & 25: Ishihara disclose a method for making the cellulose particle composition by distributing the cellulose particles in a solution of copper hydroxide and adjusting the pH so that the copper compound is retained in the cellulose particles (paragraph 7 & Working example 1).

Claim 31: Ishihara et al. disclose a process whereby the cellulose particles contain 2.9% copper (Working example 1).

Claim 32: Ishihara et al. disclose a process whereby the cellulose particles are 24 µm in size (Working example 1).

Claims 33 & 34: Ishihara et al. disclose a process whereby the copper hydroxide contained in the cellulose particles is inorganic and water insoluble (Working example 1).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

9. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein

were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

10. Claims 24 & 28-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ishihara et al. (JP 2003-102813, witnessed by the machine translation previously supplied to applicant) in view of Ito (JP 200-060338 witnessed by the machine translation attached).

Applicant claims

Applicant claims s a process for producing a paper powder that retains a copper and/or zinc compound for deodorizing purposes.

Determination of the scope and content of the prior art (MPEP 2141.01)

Since claims 28-30 depend from claim 24, rejection of claim 24 under 35 USC 103 is also appropriate. Detailed discussion of the rejection of claim 24 and the teachings of Ishihara et al. appears in the 102 section above.

Ascertainment of the difference between the prior art and the claims (MPEP 2141.02)

The difference between the teachings of Ishihara et al. and the instant claims is that Ishihara et al. does not teach the claimed source of the cellulose particles (paper powder). This deficiency in Ishihara et al. is cured by the teachings of Ito.

Ito teaches, as a whole, a method of making a paper powder by granulating waste paper.

Ito teaches that the source for the granulation of paper powder is "the ground product of disposable diaper scrap wood, the ground product of the cutting waste at the time of manufacture of a disposable diaper, Paper scrap wood ground products, such as ground product disposable diaper scrap wood powder etc. of the paper in which the paraffin film or the plastic material film is covered for the surfaces, such as a ground product of printed papers, such as punch waste, scrap paper, a printed newspaper, a magazine, and an advertisement, or lamination paper, or the mixture of a more than [these]" (paragraph 6).

Finding of *prima facie* obviousness
Rationale and Motivation (MPEP 2142-2143)

It would have been *prima facie* obvious to one of ordinary skill in the art at the time the claimed invention was made to use the paper powder granules made through the process taught by Ito in the composition of Ishihara et al. and produce the instant invention. The skilled artisan would have been motivated to use the waste paper sources and conversion method of Ito to make the paper powder because it is economically and ecologically responsible to re-use waste if possible.

From the teachings of the references, it is apparent that one of ordinary skill in the art would have had a reasonable expectation of success in using the paper powder granules made through the process taught by Ito in the composition of Ishihara et al. and producing the claimed invention. Therefore, the invention as a whole would have

been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made, as evidenced by the references, especially in the absence of evidence to the contrary.

In light of the forgoing discussion, one of ordinary skill in the art would have concluded that the subject matter defined by the instant claims would have been obvious within the meaning of 35 USC 103(a).

Conclusion

Claims 1, 3, 24, 25, & 28-34 art rejected. Claims 2, 4-23, 26, 27, & 35-49 are withdrawn. No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher R. Lea whose telephone number is (571) 270-5870. The examiner can normally be reached on Mon-Fri 8:00-4:30 ET.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter can be reached on (571)272-0646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

CRL

/Johann R. Richter/
Supervisory Patent Examiner, Art Unit 1616